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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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27123	7590	07/18/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			FRENEL, VANEL	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/645,795

**Applicant(s)**

WALLACH ET AL.

**Examiner**

Vanel Frenel

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/18/05 has been entered.

### **Notice to Applicant**

2. This communication is in response to the RCE filed on 04/18/05. Claim 78 has been newly added. Claims 1-78 are pending.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-18, 22-35, 39-53, 57-58, 65, 69, 74 and 78 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The basic of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technology arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

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In the present case, claims 1-18, 22-35, 39-53, 57-58, 65, 69, 74 and 78 are non-statutory. Among this group only claims 58 and 69 recites a computer for providing an incentive incident to the purchase or re-lease of an automobile, comprising the steps of in its preamble but does not recite any technological device in the body of the claim in performing the various steps of processing" within the computer system.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

As per claims 1-18, 22-35, 39-53, 57-58, 65, 69 and 74, Examiner respectfully requests a clear and definite language tying the body of the claim to a technological device such as a computer, and not merely in the preamble.

As per claims 58 and 69, Examiner respectfully submits that the recited "computer" is utilized in a trivial manner (i.e., passively recorded). In order to pass muster under 35 U.S.C. 101, the recited technological device must be employed in a non-trivial manner (e.g.), "for providing an incentive incident to the purchase or re-lease of an automobile"

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive

recitation in the claim as a whole to breathe life and meaning into the preamble.

In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is "a computer system". Looking at the claims 1-18, 22-35, 39-53, 57-58, 65, 69, 74 and 78 as a whole, nothing in the body of the claims recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a sale and lease of an item (i.e., repeatable) used in helping buyer to calculate a premium (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-18, 22-35, 39-53, 57-58, 65, 69, 74 and 78 are deemed to be directed to non-statutory subject matter. Therefore, the rejection under 35 U.S.C. 101 is hereby maintained.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1, 5-21, 22-35, 40-53, 58, 65-69, 70-77 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Joao (6,347,302), Bell et al (6,574,606) in view of Joseph (2001/0034690).

(A) As per claim 1, Joao discloses identifying a lease on an item that corresponds to an electronically stored record, the lease having an approaching expiration date (See Joao Col.16, lines 4937 to Col.17, line 33), identifying a customer corresponding to the lease (See Joao, Col.11, lines 43-67).

Joao does not explicitly disclose a method for encouraging the purchase or re-leasing of an item after an expiration of a lease.

However, this feature is known in the art, as evidenced by Joseph. In particular, Joseph suggests a method for encouraging the purchase or re-leasing of an item after an expiration of a lease (See Bell Col.3, lines 18-67 to Col.4, lines 11-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bell within the system of Joao with the motivation of providing a hyperlink to the merchant loyalty service provider website from the merchant website whereby the customer can access the merchant loyalty service provider web site directly from the merchant web site (See Bell, Col.1, lines 51-55).

Joao and Bell do not explicitly disclose offering the customer a paid insurance policy in exchange for purchasing or re-leasing the item after the expiration date.

However, this feature is known in the art, as evidenced by Joseph. In particular,

Joseph suggests offering the customer a paid insurance policy in exchange for purchasing or re-leasing the item after the expiration date (See Joseph, Page 5, Paragraphs 0045 –0047).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Joseph within the collective teachings of Joao and Bell with the motivation of providing a method for facilitating transfer of vehicle leases between parties involves providing a database of vehicle lease records concerning vehicle leases available for transfer (See Joseph, Page 1, Paragraph 0009).

(B) As per claim 5, Joao discloses the method wherein the insurance policy covers the item upon a completion of the purchase of the item by the customer (Col.6, lines 7-57).

(C) As per claim 6, Joao discloses the method further comprising: entering into a sales agreement with the customer (Col.11, lines 22-60).

(D) As per claim 7, Joao discloses the method, further comprising: paying a premium to an insurance provider for the insurance for the item (Col.11, lines 66-67 to Col.12, line 54).

(E) As per claim 8, Joao discloses the method wherein the insurance policy has a maximum term of one year (Col.18, lines 11-30).

(F) As per claim 9, Joao discloses the method wherein the item is an automobile of a particular make and a model (Col.11, lines 32-42).

(G) As per claim 10, Joao discloses the method wherein the insurance policy covers comprehensive losses relating to the item (Col.12, lines 39-67).

(H) As per claim 11, Joao discloses the method wherein the insurance policy covers collision losses relating to the item (Col.12, lines 39-67).

(I) As per claim 12, Joao discloses the method wherein the insurance policy is provided without consideration of further characteristics of the buyer by an insurance provider (Col.9, lines 15-67, Col.34-53).

(J) As per claim 13, Joao discloses the method wherein tile insurance policy covers all users of the item (Col.9; lines 15-67).

(K) As per claim 14, Joao discloses the method wherein said offering further comprises paying at least a portion of the insurance premium for the insurance policy (Col.9; lines 25-67, Col.14, lines 29-65).

(L) As per claim 15, Joao discloses the method wherein said paying further comprises: paying the insurance premium to an affiliate for the insurance policy



(Col. 13, lines 34-67; Col. 14, lines 29-67).

(M) As per claim 16, Joao discloses the method wherein the insurance premium is the same for each of a class of items to which the item belongs (Col.6, lines 7-67).

(N) As per claim 17, Joao discloses the method wherein the customer must reside in a selected geographic region to receive the insurance (Col.6, lines 7-67).

(O) As per claim 18, Joao discloses the method wherein the insurance is provided based on a class of the item and a geographic region which the customer resides, without consideration of further characteristics of the buyer by an insurance provider (Col.6, lines 7-67).

(P) As per claim 19, Joao discloses means for identifying a lease on an item, the lease having an approaching expiration date (See Joao, Col.11, lines 43-67), means for identifying a customer corresponding to the lease (See Joao, Col.11, lines 43-67); an apparatus for encouraging a purchase of an item after an expiration of a lease for the item See Bell Col.3, lines 18-67 to Col.4, lines 11-51).

Joao and Bell do not explicitly disclose means offering the customer a paid insurance policy in exchange for purchasing or re-leasing the item after the expiration date.

However, this feature is known in the art, as evidenced by Joseph. In particular,

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Joseph suggests means offering the customer a paid insurance policy in exchange for purchasing or re-leasing the item after the expiration date (See Joseph, Page 5, Paragraphs 0045 –0047).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Joseph within the collective teachings of Joao and Bell with the motivation of providing a method for facilitating transfer of vehicle leases between parties involves providing a database of vehicle lease records concerning vehicle leases available for transfer (See Joseph, Page 1, Paragraph 0009).

(Q) As per claim 20, Joao discloses a processor (See Joao, Col.1 1, lines 22-31), and a memory in communication with the processor, the memory for storing a plurality of processing instructions enabling the processor to: identify a lease on an item the lease having an approaching expiration date (See Joao, Col.15, lines 49-67 to Col.16, line 65), identify a customer corresponding to the lease (See Bell, Col.15, lines 49-67 to Col.16, line 65); an apparatus for encouraging a purchase of an item after an expiration of a lease for the item (See Bell Col.3, lines 18-67 to Col.4, lines 11-51).

Joao and Bell do not explicitly disclose provide an offer to the customer for an insurance policy for the item in exchange for purchasing the item after the expiration date.

However, this feature is known in the art, as evidenced by Joseph. In particular,

Joseph suggests provide an offer to the customer for an insurance policy for the item in exchange for purchasing the item after the expiration date (See Joseph, Page 5, Paragraphs 0045 –0047).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Joseph within the collective teachings of Joao and Bell with the motivation of providing a method for facilitating transfer of vehicle leases between parties involves providing a database of vehicle lease records concerning vehicle leases available for transfer (See Joseph, Page 1, Paragraph 0009).

(R) Claim 21 differs from claims 1 and 19-20, by reciting a computer-readable medium encoded with processing instructions for implementing a method, performed by a computer, for encouraging a purchase of an item after an expiration of a lease for the item.

As per this limitation, it is noted that Joao discloses the method comprising: identifying a lease on an item, the lease having an approaching expiration date, identifying a customer corresponding to the lease (See Joao, Col.11 , lines 43-67); performed by a computer, for encouraging a purchase of an item after an expiration of a lease for the item (See Bell Col.3, lines 18-67 to Col.4, lines 11-51) and Joseph discloses offering the customer an insurance policy for the item in exchange for purchasing the item after the expiration date (See Joseph, Page 5, Paragraphs 0045 – 0047).

Thus, it is readily apparent these prior art systems utilize a computer-readable

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medium encoded with processing instructions for implementing to perform their specified function.

The remainder of claim 21 is rejected for the same reason given above for claims 1, and 19-20, and incorporated herein.

(S) Claim 58 differs from claims 1, and 19-20 by reciting a method operable on a computer for providing an incentive incident to the purchase or re-lease of an automobile.

As per this limitation, it is noted that Joao discloses comprising the steps of: identifying a plurality of automobile models for which it is identifying a plurality of leased automobiles, each of said leased automobiles comprising one of said plurality of automobile models, each of said plurality of leased automobiles owned by a respective lessee, each of said plurality of leased automobiles scheduled to come off lease on an approaching expiration date (See Joao Col.11, lines 22-67, Col.12, lines 26-67 to Col.14, line 65), initiating to the lessee of each of said plurality of leased automobiles an offer to pay at least a portion of an insurance premium for an automobile insurance policy covering said current lessee for the currently leased automobile if the lessee purchases or releases the currently leased automobile upon the expiration date (See Joao, Col.9, lines 8-67), paying, upon the purchase or re-lease of at least one of said plurality of leased automobiles by a current lessee, at least a portion of the cost of the automobile insurance policy covering said current lessee for

the purchased or re-leased automobile (See Joao, Col.9, lines 8-67); an incentive to encourage the sale or re-lease of said plurality of automobile models (See Bell, Col.3, lines 18-67 to Col.4, line 51); and Joseph discloses initiating the issuance of said automobile insurance policy covering said current lessee covering said current lessee for the purchased or re-leased automobile (See Joseph, Page 4, Paragraphs 0043-0044).

Thus, it is readily apparent these prior art systems utilize a computer for providing an incentive incident to the purchase or re-lease of an automobile to perform their specified function.

The remainder of claim 58 is rejected for the same reason given above for claims 1 and 19-20, and incorporated herein.

(T) Claims 65-69 and 74-77 recite the same limitations as claim 58 above, are therefore rejected under the same rationale.

(U) Claims 22-35 and 40-53 recite the underlying process of the elements of claims 5-18, and respectively. As the various elements of claims 5-18 have been shown to be either disclosed by or obvious in view of the collective teachings of Joao, Bell and Joseph, it is readily apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 22-35 and 40-53 are rejected for the same reasons given above for system claims 5-18, and incorporated herein.

(V) Claims 70-73 recite the underlying process of the elements of claims 59-63, and respectively. As the various elements of claims 59-63 have been shown to be either disclosed by or obvious in view of the collective teachings of Joao, Bell and Joseph, it is readily apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 70-73 are rejected for the same reasons given above for system claims 59-63, and incorporated herein.

7. Claims 2, 38-39 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (6,347,302), Bell et al (6,574,606) in view of Ryan et al (6,304,859).

(A) As per claim 2, Joao discloses identifying a customer record electronically stored having a lease on an item, the lease having an approaching expiration date (See Joao Col.16', lines 49-67 to Col.17, line 33), and determining a term for an insurance policy, the insurance policy having an insurance premium at most equal to the difference (See Joao Col.7, lines 66-67 to Col.8, line 67).

Joao does not explicitly disclose a method for encouraging the purchase or re-leasing of an item after an expiration of a lease.

However, this feature is known in the art, as evidenced by Joseph. In particular, Joseph suggests a method for encouraging the purchase or re-leasing of an item after an expiration of a lease (See Bell Col.3, lines 18-67 to Col.4, lines 11-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bell within the system of Joao with the motivation of providing a hyperlink to the merchant loyalty service provider website from the merchant website whereby the customer can access the merchant loyalty service provider web site directly from the merchant web site (See Bell, Col.1, lines 51-55).

Joao and Bell do not explicitly disclose calculating a difference between an actual residual value and a projected residual value of the item; and if the customer purchases or re-leases the item at the expiration of the lease, paying the insurance premium on behalf of the customer for the term of the insurance policy.

However, these features are known in the art, as evidenced by Ryan. In particular, Ryan suggests calculating a difference between an actual residual value and a projected residual value of the item (See Ryan, Col.6, lines 5-67), and if the customer purchases or re-leases the item at the expiration of the lease, paying the insurance premium on behalf of the customer for the term of the insurance policy (See Ryan, Col. 6, lines 5-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Ryan within the combined teachings of Joao and Bell with the motivation of providing a system performing three processes which ideally occur simultaneously, namely, 1) optimal premium determination, 2) current cash value monitoring, and 3) periodic reporting (See Ryan Col.5, lines 16-19).

(B) As per claim 38, Joao discloses a computer-readable medium encoded with

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processing instructions for implementing a method, performed by a computer (See Joao Col.5, lines 38-67 to Col.6, line 6), for encouraging the purchase of an item after an expiration of a lease for the item (See Bell, Col.3, lines 18-67), the method comprising: identifying a customer having a lease on an item, the lease having an approaching expiration date (See Joao Col.15, lines 49-67 to Col.16, line 65).

Joao does not explicitly disclose a method for encouraging the purchase or re-leasing of an item after an expiration of a lease.

However, this feature is known in the art, as evidenced by Joseph. In particular, Joseph suggests a method for encouraging the purchase or re-leasing of an item after an expiration of a lease (See Bell Col.3, lines 18-67 to Col.4, lines 11-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bell within the system of Joao with the motivation of providing a hyperlink to the merchant loyalty service provider website from the merchant website whereby the customer can access the merchant loyalty service provider web site directly from the merchant web site (See Bell, Col.1, lines 51-55).

Joao and Bell do not explicitly disclose calculating a difference between an actual residual value and a projected residual value of the item; determining a term for an insurance policy, the insurance policy having an insurance premium at most equal to the difference; and if the customer purchases the item at the expiration of the lease, paying at least a portion the insurance premium on behalf of the customer for the term of the insurance policy.

However, these features are known in the art, as evidenced by Ryan. In



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particular, Ryan suggests calculating a difference between an actual residual value and a projected residual value of the item (See Ryan, Col.6, lines 5-67), determining a term for an insurance policy, the insurance policy having an insurance premium at most equal to the difference (See Ryan, Col.6, lines 5-67) and if the customer purchases the item at the expiration of the lease, paying at least a portion the insurance premium on behalf of the customer for the term of the insurance policy (See Ryan, Col.6, lines 5-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Ryan within the combined teachings of Joao and Bell with the motivation of providing a system performing three processes which ideally occur simultaneously, namely, 1) optimal premium determination, 2) current cash value monitoring, and 3) periodic reporting (See Ryan Col.5, lines 16-19).

(C) Claim 39 recites the same limitations as claim 38 above, is therefore rejected under the same rationale.

(D) Claim 56 recites the same limitations as claim 38 above, is therefore rejected under the same rationale.

8. Claims 3-4, 36-37, 54-55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (6,347,302) in view of Ryan et al (6,304,859).

(A) As per claim 3, Joao discloses a method for receiving an insurance policy for

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an item, comprising: leasing an item for a predetermined period of time (See Joao, Col.13, lines 34-67 to Col.14, line 65), creating an electronic record associated with the item, storing the electronic record (See Joao Col.16, lines 49-67 to Col.17, line 33); purchasing the item at the expiration of the predetermined period of time (See Joao; Col.13, 34-67 to Col.4, line 65).

Joao does not explicitly disclose receiving an insurance policy for the item, wherein at least a portion of the premium corresponding to the insurance policy is paid by a third party in exchange for the purchase of the item.

However, this feature is known in the art, as evidenced by Ryan. In particular, Ryan suggests receiving an insurance policy for the item, wherein at least a portion of the premium corresponding to the insurance policy is paid by a third party in exchange for the purchase of the item (See Ryan, Col.4, lines 22-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Ryan within the system of Joao with the motivation of providing a system performing three processes which ideally occur simultaneously, namely, 1) optimal premium determination, 2) current cash value monitoring, and 3) periodic reporting (See Ryan Col.5, lines 16-19).

(B) As per claim 4, Joao discloses the method wherein said purchasing comprising re-leasing the item (Col.1 , lines 5-12, Col.2, lines 58-67 to Col.3, line 40).

(C) Claim 36 differs from claim 3 by reciting an apparatus for encouraging the purchase of an item after all expiration of a lease for the item.

As per this limitation, it is noted that Joao discloses means for identifying a customer having a lease on all item, the lease having an approaching expiration date (Col.1 1, lines 43-67), means for calculating a difference between all actual residual value and a projected residual value of the item; means for determining a term for an insurance policy, the insurance policy having an insurance premium at most equal to the difference (See Joao Col.7, lines 66-67 to Col.8, line 67) and Ryan discloses means for calculating a difference between all actual residual value and a projected residual value of the item (See Ryan, Col.6, lines 40-67., Col.12, lines 1-67), and means for paying at least a portion of the insurance premium on behalf of the customer for the term of the insurance policy if the customer purchases the item at the expiration of the lease (See Ryan, Col.13, lines 1-67 to Col.14, line 67).

Thus, it is readily apparent these prior art systems utilize an apparatus for encouraging the purchase of an item after all expiration of a lease for the item to perform their specified function.

The remainder of claim 36 is rejected for the same reason given above for claims 1-3, and 19-21 , and incorporated herein.

(D) As per claim 37, Joao discloses a processor (Col.11, lines 22-31), and a memory in communication with the processor, the memory for storing a plurality of processing instructions enabling the processor to: identify a customer having a lease

on all item, the lease having an approaching expiration date (Col.15, lines 49-67 to Col.16, line 65), determine a term for an insurance policy the insurance policy having an insurance premium at most equal to the difference (See Joao Col.7, lines 6637 to Col.8, line 67), an apparatus for encouraging the purchase of an item after an expiration of a lease for the item (See Bell, Col.3, lines 18-67).

Joao and Bell do not explicitly disclose calculate a difference between all actual residual value and a projected residual value of the item; and pay at least a portion of the insurance premium on behalf of the customer for the term of the insurance policy, if the customer purchases the item at the expiration of the lease.

However, these features are known in the art, as evidenced by Ryan. In particular, Ryan suggests calculate a difference between all actual residual value and a projected residual value of the item (See Ryan, Col.6, lines 5-67), and pay at least a portion of the insurance premium on behalf of the customer for the term of the insurance policy, if the customer purchases the item at the expiration of the lease (See Ryan, Col.6, lines 5-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Ryan within the combined teachings of Joao and Bell with the motivation of providing a system performing three processes which ideally occur simultaneously, namely, 1) optimal premium determination, 2) current cash value monitoring, and 3) periodic reporting (See Ryan Col.5, lines 16-19).

(E) Claim 54 recites the same limitations as claim 36 above, is therefore rejected

under the same rationale.

(F) Claim 55 recites the same limitations as claim 37 above, is therefore rejected under the same rationale.

(G) As per claim 57, Joao discloses a method for receiving an insurance policy for an item, comprising: leasing an item for a predetermined period of time (Col.13, lines 34-67 to Col.14, line 65), entering into a new lease agreement for the item at the expiration of the predetermined period of time (See Joao; Col.11, lines 18-67, Col.13, 34-67 to Col.4, line 65).

Joao does not explicitly disclose receiving an insurance policy for the item, wherein at least a portion of the premium corresponding to the insurance policy is paid by a third party.

However, this feature is known in the art, as evidenced by Ryan. In particular, Ryan suggests receiving an insurance policy for the item, wherein at least a portion of the premium corresponding to the insurance policy is paid by a third party (See Ryan, Col.4, lines 22-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Ryan motivation of providing a system performing within the system of Joao with the simultaneously, monitoring, and 3) periodic reporting (See Ryan Col.5, lines 16-19) three processes which ideally occur namely, 1) optimal premium determination, 2) current cash value

9. Claim 78 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (6,347,302) in view of Joseph (2001/0034690).

(A) As per claim 78, Joao discloses a method for receiving an insurance policy for an item, comprising: leasing an item for a predetermined period of time (See Joao, Col.13, lines 34-67 to Col.14, line 65); creating an electronic record on a computer that includes item information, lessee information and an expiration date associated with the duration of the lease (See Joao, Col.16, lines 49-67 to Col.17, line 33); storing the electronic record (See Joao Col.16, lines 49-67 to Col.17, line 33).

Joao does not explicitly disclose creating an offer to purchase the item at the expiration of the predetermined period of time; and incorporating an insurance policy for the item, wherein at least a portion of the premium corresponding to the insurance policy is paid by a third party, as part of the purchase offer; and transmitting the purchase offer to the lessee based on the electronic record.

However, these features are known in the art, as evidenced by Joseph. In particular, Joseph suggests creating an offer to purchase the item at the expiration of the predetermined period of time (See Joseph, Page 5, Paragraph 0045); and incorporating an insurance policy for the item, wherein at least a portion of the premium corresponding to the insurance policy is paid by a third party, as part of the purchase offer (See Joseph, Page 4, Paragraphs 0043-0045); and transmitting the purchase offer to the lessee based on the electronic record (See Joseph, Page 4, Paragraphs 0043-0045).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Joseph within the system of Joao with the motivation of providing a computer-based system for facilitating transfer of vehicle leases between parties includes a web site computer system including a database of vehicle lease records concerning vehicles available for transfer (See Joseph, Page 1, Paragraph 0010).

### ***Response to Arguments***

10. Applicant's arguments filed on 04/18/05 with respect to claims 1-78 have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited not applied art teaches system and method for generating automated quotes and for credit processing (2002/0082860).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on Monday-Thursday from 6:30 am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final

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communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-

1113.

V.F  
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July 7, 2005



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